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OFFICE OF PETITIONS

In re Application of	:	
Schachar	:	
Application No. 09/556,143	:	DECISION
Filed: 21 April, 2000	:	
Attorney Docket No. PRES06-00163	:	

This is a decision on the petition filed on 31 August, 2007, under 37 C.F.R. §1.47(b).

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.¹

For the reasons set forth below, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

NOTES:

Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";

Thereafter, there will be no further reconsideration of this matter.

¹ **NOTE:** Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

BACKGROUND

The record indicates:

- the instant application was filed on 21 April, 2000;
- on 29 June, 2007 the Examiner mailed a final Office action objecting to the oath/declaration then in the file and indicating, *inter alia*, that a new fully executed oath/declaration (signed and dated) was required;
- on 31 August, 2007, and Petitioner William A. Munck (Reg. No. 39,308), filed, *inter alia*, the petition with no averment of irreparable harm/damage, an averment of assignment, but without an oath/declaration executed by a proper authority of the assignee, though with a showing as to transmittal of the entire application (description, claims, abstract and drawings) to the non-signing sole inventor Ronald A. Schachar (Mr. Shachar), but without a showing as to Petitioner's determination of the last known/reasonably believed valid address for the non-signing inventor.

What is clear from the outset, is that the petition fails to satisfy statutory, regulatory and policy requirements in that the oath/declaration appears to be unsigned and is absent the certificate under 37 C.F.R. §3.73(b)—this failure alone requires dismissal.

Additionally, Petitioner also must demonstrate the due diligence required to ascertain an address to be used/supplied for the non-signing inventor (i.e., a residence address) is current or at the very least the most reasonably believed to be last known address for the non-signing inventor.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office are to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

See specifically, the regulations at 37 C.F.R. §10.18.

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

When one alleges a refusal of the inventor to sign the application papers, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who, *inter alia*, presented the inventor with the application papers and/or to whom the refusal was made. Petitioner is directed to the commentary at MPEP §409.03(d), which provides in pertinent part:

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

Further, the guidance in the Commentary at MPEP §409.03(b)(A) and (B) provide in pertinent part:

In addition to other requirements of law (35 U.S.C. §§111(a) and 115), an application deposited pursuant to 37 C.F.R. §1.47(b) must meet the following requirements:

(A)The 37 C.F.R. §1.47(b) applicant must make the oath required by 37 C.F.R. §1.63 and §1.64 or §1.175. Where a corporation is the 37 C.F.R. §1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 C.F.R. §1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 C.F.R. §1.47(b).

(B)The 37 C.F.R. §1.47(b) applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64. (Emphasis supplied.)

Thus, Petitioner must submit an executed oath/declaration and support that document by a certificate under 37 C.F.R. §3.73(b).

Moreover, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application—and evidence of that transmittal submitted—but also a reasonable effort must be made to ascertain a current or last known address, which information is to appear over the signature and registration number of the Petitioner along with evidence of the due diligence effort ascertaining same.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

(The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.³)

Petitioner's attention is directed to the discussion in the BACKGROUND and ANALYSIS, above, and should ensure that the deficiencies addressed there are corrected with any future petition herein, to include (but not necessarily be limited to) the requirements that a copy of the transmittal letter forwarding the entire application (description, claims, abstract and drawings) to, and evidencing reasonable diligence in ascertaining a reasonably believed last known/current address for the non-signing inventor, all as required by law.

Thus, any renewed petition by Petitioner must include:

- the required signed oath/declaration and showing under 37 C.F.R. §3.73(b);
- demonstrated due diligence as required to ascertain an address to be used/supplied for the non-signing inventor (i.e., a residence address) is current or at the very least the most reasonably believed to be last known address for the non-signing inventor.

CONCLUSION

Therefore, the instant petition hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:⁴

By mail: Commissioner for Patents⁵
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
 (571) 273-8300
 ATTN.: Office of Petitions

³ See: MPEP 409.03(b).

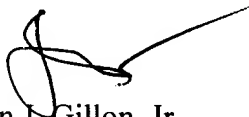
⁴ On July 15, 2005, the Central Facsimile (FAX) Number changed from (703) 872-9306 to (571) 273-8300. Old number(s) no longer are in service and (571) 273-8300 is the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

⁵ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

Application No. 09/556,143

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.